

PTO/SB/21 (04-04)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paper Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>TRANSMITTAL FORM</b> (to be used for all correspondence after initial filing)	Application Number	09/828,601
	Filing Date	Apr 6, 2001
	First Named Inventor	Eikenberg, Steven L.
	Art Unit	3732
	Examiner Name	Melba Bumgarner
Total Number of Pages in This Submission	Attorney Docket Number	182.0016

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance communication to Technology Center (TC) <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	William E. Bradley
Signature	
Date	August 3, 2004

CERTIFICATE OF TRANSMISSION/MAILING			
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.			
Typed or printed name			
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

In you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



AF13732 \$3R  
IFU

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/17 (10-03)  
Approved for use through 07/31/2006. OMB 0651-0032  
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant Claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$)**330.00**

## Complete if Known

Application Number	09/828,601
Filing Date	4/6/2001
First Named Inventor	Eikenberg
Examiner Name	Melba Bumgarner
Art Unit	3732
Attorney Docket No.	182.0016

## METHOD OF PAYMENT (check all that apply)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

☒ Deposit Account

Deposit  
Account  
Number  
  
Deposit  
Account  
Name

21-0380

U.S. ARMY

The Director is authorized to: (check all that apply)

☒ Charge fee(s) indicated below ☒ Credit any overpayments

☐ Charge any additional fee(s) or any underpayment of fee(s)

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims		Extra Claims		Fee from below	Fee Paid
Independent	Multiple Dependent	-20**=	-3**=		

Large Entity		Small Entity		Fee Description
Fee Code	Fee (\$)	Fee Code	Fee (\$)	
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

\*\* or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Entity		Small Entity		Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330.00
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\*Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$)**330.00**

## SUBMITTED BY

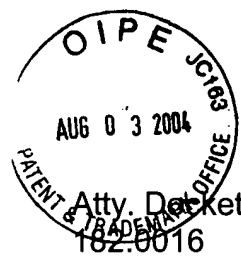
Complete (if applicable)

Name (Print/Type)	George A. Metzenthin	Registration No. (Attorney/Agent)	41,995	Telephone	202-331-8777
Signature	<i>George A. Metzenthin</i>	by permission of Elizabeth Arwine		Date	8/3/04

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

STEVEN L. EIKENBERG

Serial No.: 09/828,601

Group Art Unit: 3732

Filed: April 6, 2001

Examiner: Melba Bumgarner

For: EASY ACCESS DENTAL FIELD OPERATING AND  
TREATMENT SYSTEM HAVING OVER-THE-PATIENT  
DELIVERY

**APPLICANT'S BRIEF ON APPEAL**

**1. Real Party in Interest**

The real party in interest is the United States Government as represented by the Secretary of the United States Army.

**2. Related Appeals and Interferences**

There are no other appeals or interferences known to Applicant.

**3. Status of the Claims**

Claims 1-10 and 18-21 are pending. Claims 11-17 were cancelled without prejudice in response to a restriction requirement. Claims 22-26 were cancelled via Applicant's responsive submission filed in conjunction with the Request for Continued Examination (RCE). Claims 1-10 and 18-21 were finally rejected in the first Office Action in the RCE and are the claims on appeal.

**4. Status of Amendments**

An Amendment After Final Rejection was filed on May 4, 2004. This Amendment was denied entry in an Advisory Action mailed May 24, 2004.

**5. Summary of Invention**

"The present application relates, in general, to portable dental treatment systems." Specification, p.1, ln 11-12. "Portable dental treatment systems are

08/10/2004 AWONDAF1 00000002 210380 09828601

01 FC:1402 330.00 DA

dental treatment systems which have been designed such that they can be compacted and bundled so that a relatively fit person (e.g., a man or a woman) can physically carry the portable dental system.” Specification, p.1, ln 15-8. The portable dental treatment systems of the present invention allow for the provision of what is known as “over-the-patient” delivery of dental services as opposed to prior art portable dental treatment systems which only allowed for “side-of-the-patient” treatment. Specification, p. 3, ln 18 to p.4, ln 18. This feature of the invention is achieved by providing a portable base unit 102 coupled to a dental bracket table 104 via a suspension device 114. See specification, p.4, ln 19-32.

According to the invention and as depicted in Figure 1 “portable base unit 102 (in one implementation, portable base unit 102 houses a device for at least partially driving a dental operatory, such as an air compressor, or a suction pump, or an electric motor, etc.),” specification, p. 4, ln 21-23, is coupled to a “dental bracket table 104 (further illustrated is that dental bracket table 104 can include but is not limited to dental tray 106 and dental hand piece holders108 . . . .), specification, p.4, ln 24-26, via a “suspension device 114 . . . where suspension device 114 is structured to allow a dental patient chair to be positioned substantially below dental bracket table 104 (e.g., such as is depicted in FIGURE 2),” specification, p.4, ln 28-31. The suspension of the dental bracket table over a patient chair allows for the provision of “over the-patient” dental treatment. Specification, p. 3, ln 25 to p.4, ln 18.

Portable dental treatment systems are particularly advantageous in that they allow for treatment in many environments where fixed, office dental systems are impractical, such as areas where there are no power or sewer facilities. Speicification, p.1, ln 19 to p.2, ln 6. In this regard, the portable dental treatment systems of the present invention may include a clean water bottle and a waste water bottle. Provisional Application, p. C3, D21 and D26 (incorporated-by-reference) and FIG. 1A and FIG. 4A.

## **6. Issues**

The issues on appeal are:

- (i) Whether the Examiner erred in rejecting claims 1-10 and 18-21 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement on the asserted grounds that “[I]t is not clear from the provisional application that the waste container is a feature of the claimed invention, and as labeled on the correction to figures 1A and 4A and as described in the new paragraph to the specification.”
- (ii) Whether the Examiner erred in rejecting claims 1-10 and 18-21 under 35 U.S.C. 103 on the asserted grounds that the primary reference Seidman *et al.* discloses a “portable dental treatment system” because “[t]he prior art dental treatment system is portable in that it is shown to be ‘capable of being carried or moved about’ (Merriam-Webster’s Collegiate Dictionary)” or used improper hindsight to combine the isolated teachings of the secondary references.

## **7. Grouping of Claims**

Applicant concedes that all of the claims stand and fall together.

## **8. Argument**

### ***I. Issue 1 (35 U.S.C. 112 ¶ 1)***

Claims 1-10 and 18-21 were finally rejected in the Final Office Action on the grounds that “[i]t is not clear from the provisional application that the waste container is a feature of the claimed invention, and as labeled on the correction to figures 1A and 4A and as described in the new paragraph to the specification.” Office Action mailed March 4, 2004 at ¶ 4. As will be set forth in more detail below, the present rejection is improper and cannot be maintained because: (1) Applicant’s incorporation-by-reference of its copending provisional parent application in its entirety provides a specific and unequivocal written description of the claimed “waste container” feature; (2) Applicant’s drawings as filed specifically depict the claimed “waste container” and would be immediately appreciated by one of ordinary skill in the art as including and disclosing that feature; and, (3) the combination of the written material incorporated by reference

and the drawings as filed taken as a whole provide one of ordinary skill in the art a clear and unmistakable written description of the claimed "waste container" feature.

**1. Applicant's Provisional Application Was Incorporated by Reference in Its Entirety**

Material may be incorporated by reference into United States patent applications. See MPEP 608.01(p). If a document is specifically incorporated by reference, the material contained in the document is to be treated as if it was specifically set forth in the text of the patent application. "Essential material" can only be incorporated from: (1) a U.S. patent, (2) a U.S. patent application publication, or (3) a pending U.S. application. If "essential material" is improperly incorporated from a source other than those enumerated above, the applicant will be required to amend the specification to include the material incorporated by reference.

"Essential material" is defined as that which is necessary to (1) describe the claimed invention, (2) provide an enabling disclosure of the claimed invention, or (3) describe the best mode of practicing the invention. In other words, "essential material" is information necessary to satisfy an application's disclosure requirements under 35 U.S.C. 112, including the written description requirement.

The Applicant specifically incorporated-by-reference its prior copending provisional application no less than three (3) times in the present application:

This patent application hereby incorporates by reference in its entirety pending Provisional Patent Application entitled Dental Field Operating and Treatment System, Over-The-Patient Delivery System, Application No. 60/262,115, naming Steven L. Eikenberg as inventor, filed via Express Mail on 16 January 2001, and also claims the benefit of this Provisional Patent Application No. 60,262,115 under the auspices of 35 U.S.C. 119(e).

Specification, p.1, ln 4-9.

While the implementations described herein are believed by the inventor to be the best implementation, other implementation have been contemplated, such as the implementations described and depicted in the pending Provisional Patent Application entitled Dental Field Operating and

Treatment System, Over-The-Patient Delivery System, Application No. 60/262,115, naming Steven L. Eikenberg as inventor, filed via Express Mail on 16 January 2001, the contents of which are hereby incorporated by reference in their entirety.

Specification, p.7, ln 1-7.

For example, the alternate implementation shown on pages E45 and E46 of pending Provisional Patent Application entitled Dental Field Operating and Treatment System, Over-The-Patient Delivery System, Application No. 60/262,115, naming Steven L. Eikenberg as inventor, filed via Express Mail on 16 January 2001, the contents of which have been herein incorporated by reference in their entirety.

Specification, p.8, ln 23-30.

Accordingly, the Applicant is entitled to rely upon the disclosure of the provisional application for 35 U.S.C. 112 support for the claimed subject matter.

**2. Applicant's Provisional Application Contains a Written Description of the Added Features**

Applicant's provisional application contained the following passages on page C3 (and also on D21 and D26):

Diagram #10. Container mounting Ring 1

This ring will insert into a slot on the bottom section, back panel. A net will be fitted on the ring and a clean water bottle will be placed in the net.

Diagram #11. Container mounting Ring 2

This ring will insert into a slot on the bottom section, back panel. A net will be fitted on the ring and a wastewater bottle will be placed in the net.

Provisional Application at p. C3. The diagrams relating to these container rings are found at C9 (labeled "Container Mounting Ring #1") and C10 (labeled "Container Mounting Ring #2"). Given this disclosure, Applicant attempted to amend Fig. 1A and Fig. 4A to add reference numerals for the following features depicted in the figures:

- 120 first container mounting ring
- 121 second container mounting ring
- 122 net of first container mounting ring
- 123 clean water bottle
- 124 net of second container mounting ring
- 125 waste bottle

The Applicant also attempted to amend the specification to include text that elaborated on these features as understood by one of ordinary skill in the art of dentistry. The specification amendment and drawings were objected to under 35 U.S.C. 132 as containing new matter in the first Office Action of the RCE. In an Amendment After Final filed on May 4, 2004, Applicant sent formal drawings with the proposed changes and attempted to amend the specification to include the following language from the provisional application (with reference numerals added to the features):

The system may also include first container mounting ring 120. This ring will insert into a slot on the bottom section, back panel. A net 122 will be fitted on the ring 120 and a clean water bottle 123 will be placed in the net 122. The system may also include second container mounting ring 121. This ring will insert into a slot on the bottom section, back panel. A net 124 will be fitted on the ring 121 and a wastewater bottle 125 will be placed in the net 124.

The proposed Amendments to the specification and drawings were denied entry in the May 24, 2004 Advisory Action.

Given the incorporation-by-reference of the provisional application, Applicant is entitled to claim those features for which there is an adequate written description. As is clear from the cited passages above, the text from the provisional application is explicit and those features, including the “waste container,” are properly claimed subject matter in the present application. The rejection of the claims under 35 U.S.C. 112 is unsupportable given the clear and unambiguous written description for the claimed features.

**3. The Drawings As Filed in the Present Application Depict the Added Features**

“[U]nder proper circumstances, drawings alone may provide a ‘written description’ of an invention as required by § 112.” *Vas-Cath, Inc. v. Mahurkar*, 19 USPQ.2d 1111, 1118 (Fed. Cir. 1991). As for the drawings in the present application as filed, one of ordinary skill in the art of dentistry would readily appreciate that the embodiments depicted include a clean water bottle and a waste bottle. In such circumstances, an Applicant is entitled to claim such



features and amend the specification to include what the drawings disclose to one of ordinary skill in the art:

The practical, legitimate inquiry in each case of this kind is what the drawing in fact discloses to one skilled in the art. Whatever it does disclose may be added to the specification in words without violation of the statute and rule which prohibit "new matter," 35 U.S.C. 132, Rule 118, for the simple reason that what is originally disclosed cannot be "new matter" within the meaning of this law. If the drawing, then, contains the necessary disclosure, it can "form the basis of a valid claim."

*In re Wolfensperger*, 133 USPQ 537, 542 (C.C.P.A. 1962).

Given the clear written description in the provisional application and/or the clear depiction of these features in the figures, Applicant was entitled to claim these aspects of the invention and to amend the drawings to reflect these features. In fact, Applicant was obligated to amend the drawings to add reference numerals for the claimed elements. Pursuant to 37 C.F.R. ¶ 1.183, "[t]he drawing in a nonprovisional application must show every feature of the invention specified in the claims." 37 C.F.R. ¶ 1.183(a). "Where the drawings in a nonprovisioan application do not comply with the requirements . . . , the examiner shall require such additional illustration. . . . " 37 C.F.R. ¶ 1.183(c). Accordingly, it was incumbent upon Applicant to amend the figures once the additional features were added to the claims.

In view of the foregoing, Applicant respectfully submits that the rejection of claims 1-10 and 18-21 under 35 U.S.C. § 112, first paragraph, is unsupportable in view of the clear support for the claimed "waste container" in Applicant's provisional application incorporated-by-reference into the present application, the clear depiction of the "waste container" in the drawings as filed, and/or the combination of the written text and drawings taken as a whole. "To comply with the description requirement of 35 U.S.C. 112, first paragraph, . . . all that is required is that the application reasonably convey to persons skilled in the art that, as of the filing date thereof, the inventor had possession of the subject matter later claimed by him." *Forssmann v. Matsuo*, 23 USPQ.2d 1548, 1550 (Fed. Cir. 1993). Here it is clear that one of ordinary skill in the art would

appreciate that the present inventor had possession of the features set forth in the claims, including the claimed waste container.

***II. Issue 2 (35 U.S.C. 103)***

Claims 1-4, 6, 7, 10, and 18-21 have been rejected under 35 U.S.C. 103 as allegedly being unpatentable over Seidman in view of Bailey *et al.* Likewise, dependent claims 5, 8 and 9 have been rejected under 35 U.S.C. 103 as allegedly being unpatentable over Seidman in view of Bailey *et al.* in further view of Hoffmeister *et al.*, Jones, or Beier *et al.* Given that the independent claims are patentable over the art of record and that these references fail to overcome the deficiencies in the Examiner's primary combination, Applicant submits all of the claims are patentable over the art of record. More particularly, the Examiner has (1) applied a reference that does not teach or suggest a "portable dental treatment system" as that term is defined in the specification, and (2) has used impermissible hindsight in combining references to formulate the prior art rejections.

**1. The Specification's Definition of "Portable Dental Treatment Systems" Trumps Dictionary Definitions of the Word "Portable"**

In Applicant's December 22, 2003 Amendment submitted with the RCE, Applicant pointed out that Siedman *et al.*, while disclosing a device having wheels and being moveable, did not disclose or describe a "portable dental treatment system" as that term was defined in the specification. In response, the Examiner, relying on the *dictionary definition* of "portable," noted that "[t]he prior art dental treatment system is portable in that it is shown to be 'capable of being carried or moved about.'" Applicant respectfully submits that the inventor as his own lexicographer has set forth a definition in the specification that clearly excludes those systems that are merely "movable" from those that are "portable." Where a patentee acted as his own lexicographer "the patentee's definition trumps the ordinary and customary meaning that otherwise would have attached." *International Rectifier Corp. v. IXYS Corp.*, 70 USPQ.2d 1209 (Fed. Cir. 2004).

In an effort to advance the prosecution of the present application, Applicant attempted to amend the preamble in its Amendment After Final Rejection to more explicitly exclude systems that are “movable” but not “portable.” Specifically, the Applicant sought to amend the preamble to claim “[a] portable dental treatment system configured to be compacted and bundled such that a relatively fit person can physically carry the portable dental system” because the prior art, while disclosing “movable” dental treatment systems having some aspects of the claimed invention, does not teach nor suggest “portable” dental treatment systems having the claimed features. The Amendment After Final was denied entry in the Advisory Action mailed May 24, 2004 on the grounds that it did not place the application in a better condition for appeal.

In rejecting the claims, the Examiner argues that “Seidman discloses a **portable** dental treatment system” comprising a dental bracket and other features of the claims. Seidman does not teach a “portable” system. Seidman teaches a dental system having a “fixed or mobile cabinet.” Seidman at p.5. A reading of the reference indicates “mobile” as simply indicating the provision of wheels (see Fig. 1) on the cabinet so the unit can be moved around a dental office. This does not equate to the term “portable dental treatment system” set forth in Applicant’s specification:

“Portable dental treatment systems are dental treatment systems which have been designed such that they can be compacted and bundled so that a relatively fit person (e.g., a man or a woman) can physically carry the portable dental system.”

Specification, p.1, ln 15-18. “A definition of a claim term in the specification will prevail over the term’s ordinary meaning if the patentee has acted as his own lexicographer and clearly set forth a different definition.” *3M Innovative Properties, Inc. v. Avery-Dennison Corp.*, 69 USPQ.2d 1050 (Fed. Cir. 2003).

Applicant’s specification further elaborates that portable systems are adapted for use in field environments or under conditions where there is insufficient power and/or sewer facilities to accommodate fixed or dental office-type systems. See Specification, p.1, ln 19 to p.2, ln 6. There is nothing in

Seidman to teach or suggest the use of the dental unit as a “portable” system in the field or under conditions where power and/or sewer facilities are lacking. Seidman is simply another example of a dental unit for use in an office-type environment.

Applicant respectfully submits that the Examiner’s reliance on the dictionary definition of “portable” has been trumped by Applicant’s defining of the term “portable dental treatment system” in the specification. “The inconsistent dictionary definition must be rejected if the specification rebuts the ordinary and customary meaning.” *Tex. Digital Sys. Inc. v. Telegenix, Inc.*, 64 USPQ.2d 1812 (Fed. Cir. 2002). In the present case, a system which is merely mobile, e.g., having wheels, is incapable of being used in the environments wherein the “portable” systems of the present invention are intended to be used. The specification and prosecution history make clear that the systems of the present invention are those that can be *carried* by a user.

**2. The Examiner is Using Impermissible Hindsight in Combining References to Make the Prior Art Rejections**

In order to establish a prima facie case of obviousness, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1970). The mere fact that references can be combined or modified does not render the resultant combination obvious, unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ.2d 1430 (Fed. Cir. 1990). Further, a prior art reference must be considered in its entirety, i.e, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Assoc. v. Garlock, Inc.*, 220 USPQ 303 (Fed. Cir. 1983).

Applicant respectfully submits that independent claims 1 (and claims 2-10 depending therefrom) and 18 (and claims 19-21 depending therefrom) are patentable over the art of record. Specifically, Applicant respectfully submits that the Examiner is using impermissible hindsight in rejecting the claims. “It is impermissible to use the claimed invention as an instruction manual or template; to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . ‘One cannot use hindsight reconstruction to pick and

choose among isolated disclosures in the prior art to deprecate the claimed invention.” *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)(quoting *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988)). In this regard, the Examiner is using the Applicant’s specification to combine the features of portable dental systems and over-the-patient office dental systems to reach the claimed combination. However, this combination is precisely what Applicant’s invention is – a portable dental system which includes the advantageous features of an over-the-patient dental system. Before Applicant’s invention, the prior art failed to teach or suggest such a combination.

In rejecting the claims, the Examiner argues that “Seidman discloses a **portable** dental treatment system” comprising a dental bracket and other features of the claims. As already set forth above, Seidman does not teach a “portable” system as that term is defined in Applicant’s specification.

The Examiner then relies upon Bailey *et al.* for teaching “a portable dental treatment system comprising a portable suction pump.” Applicant agrees with characterization of Bailey *et al.* However, the Bailey *et al.* system suffers from the exact drawbacks Applicant’s invention was intended to overcome. Bailey *et al.* only provides for “side-of-the-patient” delivery of dental service. The Bailey *et al.* portable system includes a housing with the dental tools mounted to a tool holder **27** (Fig. 2), **127** (Figs. 9 and 10) on the side of the housing. This is precisely the problem in the prior art sought to be overcome by the present inventor – devising a system which does not require dental surgeons or assistants to pull and return instruments from an area below or beside the patient on a dental chair. As clearly set forth in the Applicant’s specification:

It has been discovered by the invention named herein (the inventor) that existing portable dental treatment systems place undue physical strain upon the providers of dental services (e.g., dental surgeons and/or dental technicians). In particular, it has been discovered by the inventor that existing portable dental treatment systems tend to provide delivery of dental services in a manner substantially different than the manner in which dental services are ordinarily provided in permanent (e.g., non-portable) dental operatories.

In permanent dental operatories, dental services are ordinarily provided to patients via what is known in the art as “over-the-patient”

mode. In contrast, in virtually all related-art portable dental treatment systems, dental services are generally provided in what will be referred to herein as "side-of-the-patient" mode. That is, rather than the dental treatment system suspending dental instruments such that a dental patient chair (and hence a patient) can be positioned substantially below the dental instruments, in related-art portable dental treatment systems, the dental instruments are often positioned in such a way that the instruments are to the side of the dental patient chair (and hence the dental patient).

Dental surgery, even under the best of working conditions, is physically fatiguing in that it requires both physical strength and manual dexterity in order to provide efficient and safe dental treatment to a dental patient (e.g., having the physical strength to remove a temporary dental crown held in place with temporary dental cement, and the manual dexterity to remove the temporary dental crown without damaging adjacent teeth). Insofar as both physical strength and manual dexterity tend to degrade with physical fatigue, permanent dental operatories are designed such that dental services can be provided with a minimal of physical strain on dental surgeons and/or dental technicians assisting dental surgeons. One aspect of such design of permanent dental operatories is over-the-patient delivery, which has been found empirically to minimize physical fatigue and strain on both dental surgeons and/or dental technicians assisting dental surgeons. The inventor has recognized that insofar as the working conditions in a portable dental operating room environment tend to be significantly degraded relative to a permanent dental operating room environment, it would be advantageous to have a portable dental treatment system which provides over-the-patient delivery of dental services in a fashion analogous to that utilized in permanent, or fixed, dental operating room environments.

Specification, p.3 ln 18 to p. 4 ln 18.

Clearly, the Applicant's specification is being used as a roadmap to combine the advantageous features of over-the-patient dental operator systems, such as Seidman, with the advantageous features of portable, self-contained systems, such as Bailey et al. However, realizing that a combination provides certain advantages using Applicant's claims as a template amounts to no more than impermissible hindsight. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be

a suggestion or motivation in the reference to do so." *Id.* at 682, 16 U.S.P.Q.2d at 1432; *see also In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references). It is well established that, even if all aspects of the claimed invention were individually known in the art, such is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). It is, therefore, incumbent upon the Examiner to provide some suggestion of the desirability of doing what the inventor has done in his formulation, imposition and maintenance of a rejection under 35 U.S.C. 103(a). "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. & Inter. 1985). Thus, for the reasons presented, the combination of Seidman and Bailey *et al.* is believed to be improper thereby rendering the rejection under 35 U.S.C. §103(a) improper.

In view of the foregoing, Applicant respectfully submits that the present invention as set forth in independent claims 1 and 18 are patentable over the art of record. With respect to the dependent claims, Applicant respectfully submits that if an independent claim is free of the art, then any claim depending therefrom is also free of the art. *In re Fine*, 5 USPQ.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully submits that the present invention is patentable over the art of record.

## **9. Appendix**

An Appendix of Claims on Appeal is attached hereto.

Date: 3 Aug 04

Respectfully submitted,

CAHN & SAMUELS, LLP

By: 

William E. Bradley, Esq.

Reg. No. 42,355

Cahn & Samuels, LLP

2000 P St., NW, Ste. 200

Washington, D.C. 20036

Telephone: (202) 331-8777

Fax: (202) 331-3838



## **APPENDIX OF CLAIMS ON APPEAL**

1. A portable dental treatment system configured to be compacted and bundled such that a relatively fit person can physically carry the portable dental system comprising:
  - at least one dental bracket table;
  - at least one portable base unit including at least one suction pump and a waste container;
  - at least one suspension device couplable between said at least one dental bracket table and said at least one portable base unit, said at least one suspension device structured to allow a dental patient chair to be positioned substantially below said at least one dental bracket table.
2. The portable dental treatment system of Claim 1, wherein said at least one dental bracket table comprises:
  - a bracket tray or a dental hand piece holder.
3. The portable dental treatment system of Claim 1, wherein said at least one portable bases unit further comprises:
  - at least one air compressor.
4. The portable dental treatment system of Claim 1, wherein said at least one portable base unit comprises:
  - an enclosure structured to support at least one dental operatory component selected from a group of dental operatory components having an air compressor, a suction pump, an electric motor, a control knob, an electrical switch, electrical circuitry, and a mechanical switch.
5. The portable dental treatment system of Claim 1, wherein said at least one suspension device structured to allow a dental patient chair to be positioned substantially below said at least one dental bracket table comprises:

a curved member operably couplable between a side of said at least one portable base unit and said at least one dental bracket table.

6. The portable dental treatment system of Claim 1, wherein said at least one suspension device structured to allow a dental patient chair to be positioned substantially below said at least one dental bracket table comprises:

a first member operably couplable with a side of said at least one portable base unit; and

a second member at least partially transverse to said first member, said second member having a first end operably couplable with said at least one dental bracket table and a second end operably couplable with said first member.

7. The portable dental treatment system of Claim 6, wherein said first member operably couplable with a side of said at least one portable base unit comprises:

said first member rotatably attachable to the side of the at least one portable base unit.

8. The portable dental treatment system of Claim 7, wherein said first member rotatably attachable to the side of the at least one portable base unit comprises:

a mounting bracket affixed to the side of said at least one portable base unit, said mounting bracket having a circular opening; and

said first member insertable in said circular opening.

at least one dental bracket table and a second end operably couplable with said first member.

9. The portable dental treatment system of Claim 6, wherein said second member having a first end operably couplable with said at least one dental

bracket table and a second end operably couplable with said first member comprises:

said second member integrally molded with said first member.

10. The portable dental treatment system of Claim 6, wherein said second member having a first end operably couplable with said at least one dental bracket table and a second end operably couplable with said first member comprises:

said second member rotatably attachable to said at least one dental bracket.

18. A method of assembling a portable dental treatment system comprising:

coupling a suspension device between at least one dental bracket table and at least one portable base unit including at least one suction pump and a waste container, said suspension device structured to allow a dental patient chair to be positioned substantially below the at least one dental bracket table.

19. The method of Claim 18, wherein said at least one dental bracket table comprises:

a bracket tray or a dental hand piece holder.

20. The method of Claim 18, wherein said at least one portable base unit comprises:

said at least one portable base unit containing a device for at least partially driving a dental operatory, the device for at least partially driving including but not limited to an air compressor, a suction pump, or an electric motor.

21. The method of Claim 18, wherein said coupling a suspension device between at least one dental bracket table and at least one portable base unit, said suspension device structured to allow a dental patient chair to be positioned substantially below the at least one dental bracket table comprises:
- operably coupling a first member with a side of the at least one portable base unit; and
  - operably coupling a second member substantially transverse to said first member such that said second member has a first end operably coupled with said at least one dental bracket table and has a second end operably coupled with said first member.